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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/711,017	03/12/85	HAMASHIMA	Y 256/F48B0-TW

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EXAMINER	
BEKSON, R	
ART UNIT	PAPER NUMBER
122	4

DATE MAILED: 10/24/85

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

- ☐ This application has been examined ☒ Responsive to communication filed on 8/12/85 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s) from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-492. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

- ☒ Claims 1-28 are pending in the application.
Of the above, claims 13-16, 19-28 are withdrawn from consideration.
- ☐ Claims _____ have been cancelled.
- ☐ Claims _____ are allowed.
- ☒ Claims 1-12, 17 and 18 are rejected.
- ☐ Claims _____ are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
- ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
- ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner, ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed _____, has been ☐ approved, ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
- ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received.
☒ been filed in parent application, serial no. 656731; filed on 10/1/84
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

It is noted that this application appears to claim subject matter disclosed in prior copending application Serial No. 656731, filed October 1, 1984. A reference to the prior application must be inserted as the first sentence of the specification of this application if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 120. See 37 CFR 1.78(a). Also, the present status of all parent applications should be included.

OK

Claims 1-12, 17 and 18 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

1. In claim 1, line 2, the word "the" should be in between the words "by" and "following" (paragraph 2)
2. Claim 1 is indefinite because the phrase "and its derivatives" makes it impossible to know what compounds are being claimed by applicant. (paragraph 2)
3. The specification is not enabling for the definition, in claim 1, of R as "aryl or a heterocyclic group". The limitations on page 2 of

the specification should appear in the claims also. (paragraph 1)

4. In claim 2, line 1, the word "the" should appear between the words "wherein" and "7-acylamido". (paragraph 2)
5. In claim 9, "pharmaceutically" is spelled wrong. (paragraph 2)
6. In claim 10 the definition of R^3 and/or R^6 as "alkyl or aralkyl ester-forming group" is not enabled by the specification, without further limitation as to the size of these moieties. Large alkyl or aryl moieties would render the compounds insoluble in water. (paragraph 1)
7. In claim 12, line 2, "consisting" is misspelled. (paragraph 2)
8. In claim 18, line 2, "to" should be replaced by "into". (paragraph 2)
9. Claim 1 is indefinite because it is not clear what applicant means by a "3-substituent of cephalosporins". (paragraph 2)

A1)

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The disclosure is objected to because of the following informalities:

Throughout the specification the word "preferable" is misused, in most instances "preferably" is the correct word

Appropriate correction of the disclosure is required.

Art Unit 122

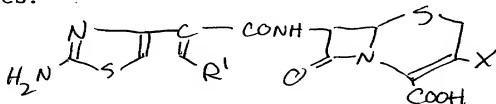
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kinast.

Kinast teaches that the following compounds are antibiotics:



wherein R1 (see column 8, lines 29-43) can be carboxy substituted alkyl and X is a conventional cephalosporin 3 position substituent.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

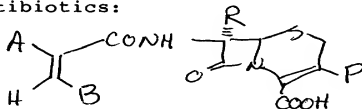
patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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Claims 1-17, 17 and 18 are rejected under 35 U.S.C. 103 as being unpatentable over Gregory, Nannini, Kinast and Boberg.

Kinast is applied as above. Gregory teaches the following antibiotics:



and physiologically acceptable salts, where (see columns 3 and 4)

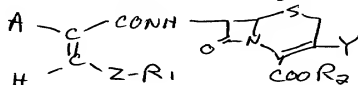
A represent an aromatic carbocyclic or heterocyclic group, in particular thienyl, furyl, phenyl, oxazole, isooxazole

B (column 4, lines 1-8) can be carboxy and/or halogen substituted alkyl.

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P (see column 4, lines 13 and forward) can be any conventional 3 position cephalosporin substituent.

Nannini teaches the following antibiotic compounds



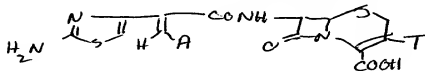
where A=phenyl or a 5 to 6 membered hetero monocyclic ring (see p2, lines 34-36)

Z= -O- or-S-

R₁ can be carboxy substituted alkyl

Y is a series of conventional cephalosporin 3 position substituents

Boberg teaches the antibiotic compounds



where A is optionally substituted alkyl and

T is a series of conventional 3 position substituents

There references, which show many compounds with very similar structures and the same utility as applicant's compounds, make applicant's invention prima facie obvious.

Claims 1-12, 17 and 18 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12, 17 and 18 of copending application Serial No. 656731.

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Serial No. 711017

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This is a provisional double patenting rejection
since the conflicting claims have not in fact been
patented.

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Benson:st

A/C 703

557-3920

10-21-85

ML Berch *for DED*

Mark L. Berch
Primary Examiner
Art Unit 122